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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,013	01/29/1999	YOICHI TAKARAGI	35.G2349	5593

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EXAMINER	
AHMED, SAMIR ANWAR	
ART UNIT	**PAPER NUMBER**
2623	

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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09/239013

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 19

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☒ is extended to run 5 month or continues to run _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☐ Applicant's response to the final rejection, filed _____ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

   a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

   b. ☐ They raise new issues that would require further consideration and/or search. (See Note).

   c. ☐ They raise the issue of new matter. (See Note).

   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

   Claims allowed: _____
   Claims objected to: _____
   Claims rejected: _____

   However;

   ☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attached

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficent reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

*U.S. GPO: 1997-417-381/62704

1.Applicant's arguments filed 3/18/03 have been fully considered but they are not persuasive with regard to claims 1, 8, 15, 19 and 26 for the following reasons:

The Applicant alleges that " claim 1 recites the first identification information conveys information relating to copyright. And directs the Examiner to line 3 [,]" (page 9, lines 712). Firstly, the Examiner still cannot find in the claim language the exact language of " the first identification information conveys information relating to copyright". The claim recites that the first identification information relating to copyright. Secondly, the color tone in Funada identifies particular kinds of originals such as securities, confidential patterns and the like (i.e., identification information), that cannot be copied based on that color tone (i.e., the color tone is related to copyright) which reads on that limitation as broadly claimed.

The Applicant alleges that " nothing has been found in Funada [,]" (page 10, last two lines-page 11, line 3). The Applicant is respectfully reminded that the rejection of the claim(s) is a combination of two references not just Funada, references cannot be argued individually to show nonobviousness (see MPEP 2145 (d)). Funada teaches upon detection of a color tone identifies particular kinds of originals such as securities, confidential patterns and the like that cannot be copied based on that color tone [first identification information relating to copyright], adding a particular pattern [second identification information] with yellow toner that is difficult to discriminate with human eye. It is clear that Funada detects a first identification information relating to copyright and adds a second identification information with yellow toner (different color) upon detecting a color tone coincides with one of 8 tones (different colors) of a document.

Funada does not disclose that the first identification information is not easily recognized with the eye. Wen discloses an identification information relating to a copyright (col. 4, lines 65-67) and not easily recognized with the eye (col. 3, lines 38-40, lines 45-47). The combination of the two references would be a system in which the document is provided with a copyright mark not easily recognized with the eye that is provided by the Wen teachings, a particular pattern that is difficult to discriminate with human eye is added to the document as taught by Funada. Funada is hiding the added particular pattern (the second information) because it is formed with yellow toner that is difficult to discriminate with human eye and the second information is added based upon the detection of the color tone (first information) as indicated above.

The Applicant alleges that " each of these references is merely directed to the use of a single identification code, printed in a single color [,]" (page 12, lines 14-23). The Examiner disagrees. Firstly, as shown above Funada discloses detecting a first identification information and adding a second identification information in different color and the combination teaches the invention as claimed. secondly, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, hiding the first identification information relating to copy right by making it

not easily recognizable with the eye would maintain the viewable quality of the image that carries the copyright information.

SAMIR AHMED
PRIMARY EXAMINER